

### **THE REMARKS**

Claims 1-21 were pending prior to entering the amendments. Claims 1-21 were rejected.

#### **The Amendments**

The amendment to the paragraph beginning at page 5, line 1 is to correct the spelling of “stabilizing.”

The amendments to the Figures 7 and 8 drawings are to correct the missing “15” label. Support for the reference sign mentioned in the description “15” is found at page 9, line 15 of the specification. The corrected drawing sheets in compliance with 37 CFR 1.121(d) are herein submitted. The amended replacement drawing sheets include all of the figures appearing on the immediate prior version of the sheets. Each drawing sheet herein submitted is labeled in the top margin as either “Replacement Sheet” pursuant to 37 CFR 1.121(d).

The amendment to Claim 1 is to clarify the claimed invention. Support for the “rigid” amendment is found at page 9, line 23 to page 10, line 3. Rigid as used in the claims means that the prongs do not deform upon being struck. The specification discusses the before-use and after-use positions of the prong members. After being struck by a club, the prong members go from an upright position to a horizontal position. (Spec. at p. 9:23-10:3). The force of the club blow causes the prong members to move to a horizontal position because the members are rigid. If the members were flexible, they would not move to a horizontal position. Support for the “of equal length” amendment is found at page 6, lines 3-4.

The amendment to Claim 5 is to remove a typographical error. The word “any” was erroneously left in the Claim after a previous amendment.

The amendment to Claim 8 is to further clarify the claimed invention. Support for this amendment is found at page 4, lines 14-20.

The amendment to Claim 10 is to fix a typographical error. In a previous amendment, the comma following “claim 8” was omitted.

Claim 11 is herein cancelled.

The amendments to Claim 12 are to clarify the claimed invention. Support for the “rigid” and “of equal length” amendments is found at page 9, line 23 to page 10, line 3 and at page 6,

lines 3-4 respectively. The other amendments to Claim 12 are to removing the limitation of the shaft being pivotable relative to the base portion was made in accordance with the Examiner's comments regarding the 35 U.S.C. § 112 rejection of Claims 12-15 and 19-21. Support for Claim 12 as amended is found at page 9, line 14 to page 10, line 14 and in Figures 6, 7 and 8.

No new matter is introduced in any of the above amendments. The Examiner is requested to enter the amendment and re-consider the application.

### **35 U.S.C. 112 Rejections - Enablement**

Claims 12-15 and 19-21 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 12-15 are herein amended to remove the implication of a pivotable connection between shaft and the base portion.

### **35 U.S.C. 102(b) Rejections**

Claims 1-4 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Chase (U.S. Patent No. 3,414,268).

Chase does not disclose a "a pivotable support portion (16) mounted atop an upper end (18) of the shaft (12), the pivotable support portion (16) having a plurality of upright prong members (40) mounted thereupon, the prong members (40) being arranged to support a golf ball placed atop the prong members (40) such that the golf ball is positioned substantially above the upright prong members (40)" as required by Claims 1-4.

Chase discloses "petals" and a "cup" for holding a golf ball that are "formed to fit the general configuration of a golf ball thus forming a cup shape for the golf ball to be inserted into." (Chase at Col. 2:31-34, 4:4-8). Each tee disclosed in Chase, including the prior art discussed in Chase, uses a "cup shaped top." (Chase at Col. 1:25-45). The mechanism for supporting the golf ball disclosed in Chase is a well-known "cup shaped top" as has been used in the "most universally used tee:" the solid wooden tee. (Chase at Col. 1:26-27). "Upright" as used in the specification means substantially vertical. (p. 9:23-10:3). The "petals" and "cup" disclosed in Chase are significantly angled and are therefore not "upright prong members" as required by Claims 1-4. (Chase Figs. 1-7).

### **35 U.S.C. 103(a) Rejections**

Claims 5 and 7-10 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chase (U.S. Patent No. 3,414,268) in view of Morabeto (U.S. Patent No. 4,645,208).

#### **Claims 5 and 7-10**

Chase and Morabeto do not teach a “a pivotable support portion (16) mounted atop an upper end (18) of the shaft (12), the pivotable support portion (16) having a plurality of upright prong members (40) mounted thereupon, the prong members (40) being arranged to support a golf ball placed atop the prong members (40) such that the golf ball is positioned substantially above the upright prong members (40)” as required by Claims 5 and 7-10.

Chase teaches that “petals” or a “cup” may be used for holding a golf ball wherein the “petals” or “cup” are “formed to fit the general configuration of a golf ball thus forming a cup shape for the golf ball to be inserted into.” (Chase at Col. 2:31-34, 4:4-8). Each tee taught in Chase, including the prior art discussed in Chase, uses a “cup shaped top.” (Chase at Col. 1:25-45). Chase teaches away from the use of “upright prong members” because the invention taught in Chase **requires** a cup shape: one of the features of the invention in Chase is the ability to angle the ball-holding mechanism while holding the golf ball. (Chase at Col. 3:21-24, Fig. 4). A cup shape has the ability to hold a golf ball even at an angle shown in Figure 4 of Chase. The “upright prong members” of the present invention contact the ball at the pointed portions of the prong members and would not allow tilting as shown in Chase. (Spec. at p. 7:4-9). Therefore, Claim 1 and its dependant claims are not obvious over Chase.

Morabeto teaches a “spherical surface 7 to serve as a seat for the golf ball.” (Morabeto at Col. 1:7-8, Figs. 1-5). Since Chase requires a cup shape and Morabeto teaches a spherical shape for the ball-holding mechanism, the “upright prong members” of the present invention are not taught by the combination of Chase and Morabeto. Therefore, Claims 5 and 7-10 are not obvious over Chase in view of Morabeto.

Further, the “upright prong members” of the present invention have several benefits lacking in both Chase and Morabeto. Unlike, the petals of Chase, or the spherical surface of Morabeto, the prong members of the present invention do not hold the ball inside their cavity, they just support the golf ball on their pointed portions. The prong members allow minimized contact with the ball that in turn allows for more distance. (Spec. at Col. 6:14-21, 7:2-9).

Regarding Claims 8 and 9, the Examiner states that Morabeto provides a downwardly sloping surface that allegedly renders the downward sloping surface of the present invention obvious. Claims 8 and 9 have been amended to add the limitation that the tee “has a substantially horizontal upper surface (52).” Support for this amendment is found at p. 4:14-20. The sloping edge of Morabeto cited by the examiner extends around the entire tee and is therefore does not teach a “substantially horizontal upper surface” as required by the Claims.

Regarding Claim 10, the Examiner states Morabeto shows markers (4) in Figures 1 and 2 that are obviously capable of being used as guidance markers. However the element labeled “4” in Figures 1 and 2 is merely an opening between the flanged fingers (3) of the Morabeto tee. (Morabeto at Col. 1:61-64). These “‘U’-shaped openings 4” extend over nearly 120 degrees as shown in Figures 1, 2 and 3. Since the openings 4 extend over such a large range, they are not obviously capable of being used as guidance markers. Further, Morabeto teaches against using guidance markers: “There will be no necessity of aligning the assembly with the vertical plane of swing of a club since this does not matter because of the universal joint.” (Morabeto at Col. 2:10-14). Using guidance markers with the tee of Morabeto would require “aligning the assembly with the vertical plane of swing” and would therefore vitiate one of the key elements of the Morabeto tee. Therefore, it would not have been obvious to use guidance markers with the Morabeto tee.

Claim 6 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chase (U.S. Patent No. 3,414,268) in view of Morabeto (U.S. Patent No. 4,645,208) and Liu (U.S. Publication No. 2004/0018896).

The Examiner states that Liu discloses that it is well known in the art of golf tees to form the shaft of the tee from two portions (20,30) so that the tee may be separated to provide a short golf tee and a longer golf tee. The tee in Liu uses a cup-shaped end to hold the golf ball. (Liu Figs. 1-5). Chase and Liu teach only a cup shape and Morabeto teaches a spherical shape for the ball-holding mechanism, it would not have been obvious over Chase in view of Morabeto and Liu to one of ordinary skill in the art to make the “upright prong members” of the present invention.

Claim 11 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chase (U.S. Patent No. 3,414,268) in view of Morabeto (U.S. Patent No. 4,645,208) and Lewis et al. (U.S. Patent No. 5,571,055).

The tee in Lewis uses a cup-shaped end to hold the golf ball. (Lewis Figs. 1-3). Chase and Liu teach only a cup shape and Morabeto teaches a spherical shape for the ball-holding mechanism, it would not have been obvious over Chase in view of Morabeto and Lewis to one of ordinary skill in the art to make the “upright prong members” of the present invention.

Claim 16 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chase (U.S. Patent No. 3,414,268) in view of St. John (GB Patent No. 2,258,161).

Claim 16 requires that the “prong members (40) are equidistantly and equiangularly arranged upon the pivotable support portion (16), the prong members (40) forming a support surface to support a golf ball placed atop the prong members (40), whilst maintaining minimal contact between a surface of the golf ball and prong members (40).”

As discussed above Chase teaches against using prong members to support a golf ball. Chase teaches away from the use of “upright prong members” because the invention taught in Chase **requires** a cup shape: one of the features of the invention in Chase is the ability to angle the ball-holding mechanism while holding the golf ball. (Chase at Col. 3:21-24, Fig. 4). A cup shape has the ability to hold a golf ball even at an angle shown in Figure 4 of Chase. A golf ball would roll off the bristles of St. John if the bristles were combined with Chase tee and used as taught in Chase.

St. John does not teach upright prong members “maintaining minimal contact between a surface of the golf ball and prong members” as required by Claim 16. The bristles in St. John are arranged to have a concave surface for contacting the ball. (St. John at 8:11-18, Figs. 1 and 2). The concave shape maximizes the bristles’ surface contact with the ball. Nearly all tees in the prior art rely on a concave or cupped shape for contacting and holding the ball. Minimizing the contact with the ball is beneficial because it allows the ball to travel a greater distance. (Spec. at 7:4-9).

Moreover, the Claim 1 and its dependant Claims including Claim 16 have been amended to clarify that the prong members of the present invention are rigid: meaning that that the prongs do not deform upon being struck. Support for this limitation is found at p. 9:23-10:3 of the

Specification which discusses the before-use and after-use positions of the prong members. After being struck by a club, the prong members go from an upright position to a horizontal position. (Spec. at p. 9:23-10:3). The force of the club blow causes the prong members to move to a horizontal position because the members are rigid. If the members were flexible, they would not move to a horizontal position. The bristles of St. John are flexible and in use “the kinetic energy of the impact with the striking instrument such as a golf club is not substantially transmitted to the support itself...the deformation including flexure of the support means.” (St. John at p. 2:13-17).

Claims 17 and 18 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Chase (U.S. Patent No. 3,414,268). As discussed above, Chase teaches against using prong members as required by Claims 17 and 18. Therefore, Claims 17 and 18 are not obvious in over Chase.

Claims 12-15 and 19-21 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jewett (2,198,968) in view of Cardarelli (D488,525).

Claims 12-15 and 19-21 are limited to “golf tees.” Jewett teaches a device for automatically teeing golf balls. The only tee-like device used in the Jewett device is “an elastic member” through which the golf ball passes and rests. (Jewett at Col. 2:7-13, 3:2-5). Jewett does not teach the golf tee of Claim 12. Particularly, Jewett does not teach a “cavity,” “pivotal support portion,” “prong members” that are pivotable, or first and second positions of the “pivotal support portion” and “prong members.”

The tee shown in Cardarelli is a traditional wooden tee. Cardarelli does not teach the golf tee of Claim 12. Particularly, Cardarelli does not teach a “cavity,” “pivotal support portion,” “prong members” that are pivotable, or first and second positions of the “pivotal support portion” and “prong members.” Therefore, since neither Jewett nor Cardarelli teach the elements of the golf tee in Claim 12, Claims 12-15 and 19-21 are not obvious over Jewett in view of Cardarelli.

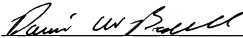
Moreover, the tee of Cardarelli would not function in the Jewett device since the Jewett tee must be hollow and flexible to allow a golf ball to pass through it. Therefore, one of ordinary skill in the art would not combine the teachings of Cardarelli and Jewett so Claims 12-15 and 19-21 are not obvious over Jewett in light of Cardarelli.

**CONCLUSION**

Applicants believe that the application is now in good and proper condition for allowance. Early notification of allowance is earnestly solicited.

Respectfully submitted,

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